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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/737,294	12/16/2003	Chien Lee	001105CIPCON	7685
26285	7590	12/01/2004	EXAMINER	
KIRKPATRICK & LOCKHART LLP			KITOV, ZEEV	
535 SMITHFIELD STREET			ART UNIT	PAPER NUMBER
PITTSBURGH, PA 15222			2836	

DATE MAILED: 12/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/737,294

Applicant(s)

LEE ET AL.

Examiner

Zeev Kitov

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply:

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2003.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2 - 30 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 2 - 30 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 16 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 07/15/04.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

DETAILED ACTION

IDS

Examiner acknowledges reception of the Information Disclosure Statement (IDS) and signed/initialized most of the references with exception of US 2,712,009 and US 4,933,661, since both references are totally irrelevant. If Applicant insists on signing these references, he is asked to explain their relevance to the current case.

Patent applicant has duty not just to disclose pertinent prior art references but to make the disclosure in such a way as not to "bury" it within other disclosures of less relevant prior art; *See Golden Valley Microwave Foods Inc. v. Weaver Popcorn Co, Inc.*, 24, USPQ2d 1801 (N.D.I. 1992); *Mollins PLC v. Textron Inc.* 26 USPQ2d 1889, at 1899 (D.Del 1992).

Objection

1. Claims 4, 8, 14 and 22 contain the trademark/trade name "EVA". Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. *See Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or

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trade name. In the present case, the trademark/trade name is used to identify/describe a conductive material and, accordingly, the identification/description is indefinite.

For purpose of examination the term was interpreted as "a conductive material".

2. Claims 3, 7, 26 and 28 are objected to due to a typing error. The word "impedence" should be retyped as "impedance".

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 2 – 4, 6, 7, 8, 10 - 15, 18 - 23, 26 - 30 are rejected under 35 U.S.C. 102(e) as being anticipated by Bisson (US 6,549,391). Regarding Claims 2, 6, 10 and 18, Bisson discloses all its elements including an electrostatic circuit for footwear

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having an outsole, an insole and a midsole between the insole and outsole (elements 16, 18, 20 in Fig. 1, col. 2, lines 52 – 59)), the electrostatic circuit including: a conductor path (element 26 in Fig. 1) having a first end and a second end (upper and bottom elements 34 and 32 in Fig. 1); a conductive pad (elements 32 in Fig. 1) attached to the first end of the conductor path; the conductive pad being attached to one of the outsole and the insole; the second end of the conductive path being attachable to the other of the outsole and the insole; and at least one resistor (element 28 in Fig. 1) electrically coupled to the conductive path between the first and second ends thereof. Actually, the conductive pads (elements 32 in Fig. 1) are attached to both insole (element 16 in Fig. 1) and outsole (element 20 in Fig. 1).

Regarding Claims 3, 7, 13 and 21, Bisson discloses the total impedance provided by the resistors is less than or equal to 10^7 ohms (col. 3, lines 6 – 7).

Regarding Claims 4, 8, 14 and 22, Bisson discloses the conductive pad being fabricated from conductive material (col. 3, lines 41 – 50).

Regarding Claims 12 and 20, Bisson discloses the outsole being fabricated from material selected from the group consisting of polyurethane and rubber (col. 3, lines 48 – 50).

Regarding Claims 15 and 23, Bisson discloses the midsole having an electrical resistance value of greater than 1×10^7 ohms (col. 3, lines 60 – 63).

Regarding Claims 11 and 19, Bisson discloses a sock liner adjacent to the insole (element 24 in Fig. 1, col. 2, line 60 – 64).

Regarding Claim 26, Bisson discloses extending a conductive path (element 26 in Fig. 1) having two ends and a resistor (element 28 in Fig. 1) between the outsole and the insole (elements 16 and 20 in Fig. 1), affixing one end of the conductive path to a conductive pad (elements 32 in Fig. 1); affixing the conductive path to the insole (by using upper element 34 in Fig. 1); and affixing another end of the conductive path to the outsole (by using bottom element 34 in Fig. 1).

Regarding Claims 27 and 29, Bisson discloses the conductive path (element 26 in Fig. 1) extending through an opening in the midsole (element 18 in Fig. 1).

As per Claim 28, it differs from Claim 26 rejected accordingly by its limitation of the conductive path including the resistor. Bisson discloses the conductive path (element 26 in Fig. 1) including the resistor (element 28 in Fig. 1).

Regarding Claim 30, Bisson discloses a conductive path (element 26 in Fig. 1) having a first end and a second end (upper and bottom elements 34 and 32 in Fig. 1) and at least one resistor (element 28 in Fig. 1) located between the first end and second ends and a conductive attachment pad assembly (elements 32 and 34 in Fig. 1, col. 3, lines 51 – 55) attached to one of the first and second ends of the conductive path.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5, 9, 17 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bisson in view of Crandell (US 2,360,763). As was stated above, Bisson discloses all the elements of Claims 1, 6, 10 and 18. However, regarding Claims 5, 9, 17 and 25, it does not disclose the conductive path being stitched to the conductive pad. Crandell discloses the conductive path being stitched to the conductive pad (page 2, col. 2, lines 1 – 12). Both references have the same problem solving area, namely providing antistatic footwear. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the Bisson solution by attaching the conductive path to the conductive by stitching according to Crandell, because as Crandell states (page 2, col. 2, lines 1 – 12), in a case of sandals, open toe, and /or heel shoes, the decorative binding is essential, and therefore the conductive material (path) can be stitched and /or cemented to the pad. And as well known in the art, the stitching together with cementing are the most popular methods of the shoe manufacturing.

Claims 16 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bisson in view of Cheskin (US 5,448,840). As was stated above, Bisson discloses all the elements of Claims 10 and 18. However, regarding Claims 16 and 24, it does not disclose the outsole having a tread pattern. Cheskin discloses the outsole having the tread (elements 31 in Fig. 2, 36 in Fig. 3, 16 in Fig. 4, and 20 in Fig. 5 and 6). Both

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references have the same problem solving area, namely providing antistatic shoes.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the Bisson solution by adding the treaded pattern outsole according to Cheskin, because as well known in the art, the treaded pattern of outsole is widely used in the shoe design to increase a traction, and as Cheskin states (col. 6, lines 14 – 56), a particular shape of the treaded pattern depends on intended use of the shoes, such as supporting basketball use or running and walking.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zeev Kitov whose current telephone number is (571) 272 - 2052. The examiner can normally be reached on 8:00 – 4:30. If attempts to reach examiner by telephone are unsuccessful, the examiner's supervisor, Brian Sircus can be reached on (571) 272 – 2800, Ext. 36. The fax phone number for organization where this application or proceedings is assigned is (703) 872-9306 for all communications.

Z.K.

11/26/2004



ROBERT L. DEBERADINIS
PRIMARY EXAMINER